

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(CASE NO. 91,875-J)

PATENT

In re Application of:

McBride and Dean

Serial No. 08/253,973

Filed June 3, 1994

For Monoamine, Diamide, Thiol-  
Containing Metal Chelating  
Agents

Group Art Unit \_\_\_\_\_

Examiner \_\_\_\_\_

The Commissioner of Patents and Trademarks  
Washington, D. C. 20231

Sir:

## TRANSMITTAL LETTER

In regard to the above-identified application:

1. We are transmitting herewith the attached

Response to Notice to File DOE Property Rights Statment and  
Declarations of William McBride and Richard T. Dean

2. With respect to additional fees:

☒ A. No additional fee is required.☐ B. An additional fee is required and has been calculated as shown below:

CLAIM AS AMENDED						
(1)	(2) CLAIMS REMAINING AFTER AMENDMENT	(3)	(4) HIGHEST NO. PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEE
TOTAL CLAIMS	.	MINUS	..			X
INDEP. CLAIMS	.	MINUS				X
				TOTAL ADDITIONAL FEE FOR THIS AMENDMENT →		

\*If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.

\*\*If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.

\*\*\*Each multiple dependent claim should be counted as the number of claims from which it depends.

☐ C. Attached is a check in the amount of \$\_\_\_\_\_.☐ D. Charge the total additional fee to our Deposit Account No. 01-0850.  
A duplicate copy of this sheet is enclosed.3. Please charge any additional fees or credit overpayment to the Deposit Account No.  
01-0850. A duplicate copy of this sheet is enclosed.4. CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal  
Letter and the paper, as described in paragraph 1 hereinabove, are being deposited in the  
United States Postal Service, as first class mail, in an envelope addressed to:  
Commissioner of Patents and Trademarks, Washington, D. C. 20231 on this 2nd

day of August, 19 94

By Kevin E. Noonan

Reg. No. 35,303

ALLEGRETTI & WITCOFF, LTD.  
10 SOUTH WACKER DRIVE  
CHICAGO, ILLINOIS 60606  
PHONE: 312-715-1000

PATENT OFFICE COPY

AUG 02 1994

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Case No. 91,875-J)

PATENT

In application of:

McBride and Dean

Serial No. 08/253,973

Filed: June 3, 1994

For: Monoamine, Diamide, Thiol-  
Containing Metal Chelating Agents

Group Art Unit:

RECEIVED

RESPONSE TO NOTICE TO FILE  
D.O.E. PROPERTY RIGHTS STATEMENT

AUG 05 1994

LICENSING & REVIEW

Honorable Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

In response to the notice mailed June 30, 1994, enclosed please find declarations from  
each inventor in compliance with 37 CFR 1.68.

Respectfully submitted,  
ALLEGRETTI & WITCOFF, LTD.

By

Kevin E. Noonan, Ph.D.  
Reg. No. 35,303

Date: August 2, 1994

91875J  
JOM/KEN



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/253,978	06/03/94	WILLIAM MCBRIDE ET AL	91,875-J

ALLEGRETTI & WITCOFF, LTD  
10 SOUTH WACKER DRIVE  
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER
	2

DATE MAILED: 06/30/94

**RECEIVED**

AUG 05 1994

**IF NO RESPONSE TO THIS NOTICE IS RECEIVED WITHIN FORTY-FIVE DAYS, A  
FORMAL REQUIREMENT WILL BE ISSUED**

The subject matter of this application appears to:

- ☒ be "useful in the production or utilization of special nuclear material or atomic energy" as recited in 42 U.S.C. 2182 (Department of Energy (DOE)).
- ☐ "have significant utility in the conduct of aeronautical and space activities" as recited in 42 U.S.C. 2457 (National Aeronautics and Space Administration (NASA)).

Accordingly, no patent can issue on this application unless applicant(s) file a statement (under oath or in the form of a declaration as provided by 37 CFR 1.68) setting forth (1) the full facts concerning the circumstances under which the invention was made and conceived and (2) the relationship (if any) of the invention to the performance of any work under any contract or other arrangement with the Agency(ies) noted above. On the reverse side of this form is an example of an acceptable format for this statement. The language appearing in paragraphs III and/or IV of the example *must* appear if applicant is attempting to establish that no relationship (under item 2 above) exists.

If the invention disclosed in this application was developed under a contract, grant or cooperative agreement between the Agency indicated above and a person, small business or non-profit organization and rights to the invention have been determined by specific reference to 35 U.S.C. 202 in the contract, grant or cooperative agreement, then applicant need not submit the statement described above. Instead, applicant may file a verified statement (under oath or in the form of a declaration, 37 CFR 1.68) setting forth the information required by 35 U.S.C. 202(c)(6).

IF NO STATEMENT HAS BEEN RECEIVED WITHIN FORTY-FIVE DAYS OF THE MAIL DATE INDICATED ABOVE, a formal requirement for statement will then be issued. No provision is made for extension of the statutory thirty-day period for response to the formal requirement and the penalty for failure to file an acceptable and timely statement is abandonment of the application. Therefore, applicants are strongly encouraged to submit a statement at this time in order to avoid the issuance of a formal requirement.

IT IS IMPORTANT TO NOTE that the statement must accurately represent the property rights situation of the claimed invention if and when the application is found allowable. Thus, if during prosecution before the examiner, the claimed invention is so altered or the property rights situation so changed as to impact the accuracy of a statement submitted earlier, a supplemental statement must be filed. Failure to submit such additional information where appropriate may be considered a false representation of material facts and render the patent owner vulnerable to loss of patent rights and other sanctions as set forth in the statutes. The PTO will not review allowed applications for this possibility. The responsibility for complying with the statutes rests with the applicants.

Any questions regarding this requirement should be directed to Licensing and Review at (703) 308-3312.

**PLEASE DIRECT ALL COMMUNICATIONS RELATING TO THIS MATTER TO THE  
ATTENTION OF LICENSING AND REVIEW**

The following is an example of an acceptable property rights statement. Statements of this type are, of course, only suitable for situations in which **NO** Agency funds or other considerations were involved in the making or conception of the invention. While this example is in the form of a declaration, a sworn document is equally acceptable.

I (We) Richard T. Dean and William McBride  
citizens of the United States  
residing at as described below,  
declare:

That I (we) made and conceived the invention described and claimed in patent application:

Serial Number 08/253,973 filed in the United States of America on June 3, 1994  
titled Monoamine, Diamide, Thiol-containing Metal Chelating Agents

(Check and complete either I or II below)

(Check III and/or IV below as appropriate)

☒ I. (For Inventors Employed by an Organization) That I (we) made and conceived this invention while employed by Diatech, Inc.. That the invention is related to the work I am (we are) employed to perform and was made within the scope of my (our) employment duties; That the invention was made during working hours and with the use of facilities, equipment, materials, funds, information and services of Diatech, Inc. Other relevant facts are \_\_\_\_\_  
(name of employer)

That to the best of my (our) knowledge and belief (and/or) based upon information provided by \_\_\_\_\_ of \_\_\_\_\_:

—OR—

☐ II. (For Self-Employed Inventors) That I (we) made and conceived this invention on my (our) own time using only my (our) own facilities, equipment, materials, funds, information and services. Other relevant facts are \_\_\_\_\_

That to the best of my (our) knowledge and belief:

☒ III. The invention was not made or conceived in the course of, or in connection with, or under the terms of any contract, subcontract or arrangement entered into with or for the benefit of the United States Atomic Energy Commission or its successors: Energy Research and Development Administration or the Department of Energy.

—AND/OR—

☐ IV. The invention was not made (conceived or first actually reduced to practice) under nor is there any relationship of the invention to the performance of any work under any contract of the National Aeronautics and Space Administration.

The undersigned inventor(s) declare further that all statements made herein of his or her (their) own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Inventor's Signature: Richard T. Dean (Richard T. Dean)

Post Office Address: 43 King Road, Bedford, New Hampshire 03110

Date: 16 July 1994

Inventor's Signature: William McBride (William McBride)

Post Office Address: 110 Golfview Drive, Manchester, New Hampshire 03102

Date: 25 July 1994

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JUL 06 1994

ROCKET  
ELECTRONIC & WITCOFF, LTD.

**(Case No. 91,875-J)**

## LICENSING & REVIEW

Laura Wiley

(Case No. 91,875-J)

**For: Monoamine, Diamide, Thiol-Containing Metal Chelating Agents**

## Group Art Unit

**RECEIVED**

**AUG 05 1994**

**LICENSING & REVIEW**

**CERTIFICATE OF MAILING BY "EXPRESS MAIL"**

**Sir:**

### Transmittal Letter & Postcard

I hereby certify that the attached paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 C.F.R. 1.10 on the date indicated above and is addressed to The Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Lauren Wiley